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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,441	05/10/2000	LASZLO BALAZS	1060-136P	1924

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EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT PAPER NUMBER

1624

DATE MAILED: 04/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/485,441

Applicant(s)

BALAZS et al.

Examiner

Brenda Coleman

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED Apr 8, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered ~~upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.~~
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

4. ☒ Applicant's reply has overcome the following rejection(s):
See attached Advisory Action
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached Advisory Action
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: 4
Claim(s) objected to: 11 and 12
Claim(s) rejected: 1-3, 5-10, 13, 14, 16, and 17
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

Brenda Coleman
BRENDA COLEMAN
PRIMARY EXAMINER
ART UNIT 1624

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ADVISORY ACTION

The shortened statutory period for response expires FIVE MONTHS from the date of the final rejection or as of the mailing date of this advisory action, whichever is later. In no event however, will the statutory period for response expire later than SIX MONTHS from the date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

The amendment filed April 8, 2002 under 37 CFR 1.116 in response to the final rejection **has been** considered and **entered**, however the amendment is not sufficient to place the application in condition for allowance.

Response to Amendment

Applicant's amendment April 8, 2002 has been fully considered with the following effect:

1. With regards to the 35 USC § 112, second paragraph rejection labeled 2b) maintained in the last office action, the applicant's arguments have been fully considered but are not found persuasive. The applicants' stated that they have amended claim to correct the phrase "which latter is optionally substituted". However, the phrase still remains in claim 9. The applicants' attention is drawn to the definition of R⁷ and R⁸ on page 13 of the amendment where R⁷ and R⁸

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form together with the adjacent nitrogen atom, an oxopyrrolidinyl group, a phthalimido group **which latter is optionally substituted...**

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For reasons of record and stated above.

2. The applicant's amendments are sufficient to overcome the 35 USC § 102, anticipation rejection of claims 1, 5-9 and 13-17 by Hamori et al., WO 96/04283 in the last office action, which is hereby **withdrawn**.
3. The applicant's amendments are sufficient to overcome the 35 USC § 102, anticipation rejection of claims 1-3, 5-7, 9-11 and 13-17 by Tarnawa et al., Bioorganic & Medicinal Chemistry Letters in the last office action, which is hereby **withdrawn**.
4. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 1-3, 5-7, 9, 10 and 13-17 by András et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive. The applicants' stated that the claims were amended to "distinguish the rejected claims from the cited Andrasi patents". The proviso of the instant invention is such that (3) if each of A and B stands for a hydrogen atom, n and m have a value of 0, then one of R³ and R⁴ represents a hydrogen atom, and the other of R³ and R⁴ is

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different from a hydrogen atom, a phenyl group or a C_{1-4} alkyl group and (4) if each of A and B stands for a hydrogen atom, n has a value of 0, m has a value of 1 or 2, and one of R^3 and R^4 represents a hydrogen atom or a C_{1-4} alkyl group, then the other of R^3 and R^4 is different from a hydrogen atom or a C_{1-4} alkyl group. Andrási teaches compounds **for example** where R^3 and R^4 form, with the adjacent nitrogen atom a pyrrolidine group and compounds where R is Cl which are not excluded by the proviso above.

Claims 1-3, 5-7, 9, 10, 13, 14, 16 and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

5. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1, 5-9 and 13-17 by Hamori et al., WO 96/04283, the applicants' failed to comment on this rejection which was maintained in the last office action.

Claims 1, 5-9, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamori et al., WO 96/04283. For reasons of record and stated above.

6. With regards to the 35 U.S.C. § 103, obviousness rejection of claims 1-3, 5-7, 9, 10 and 13-17 by Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832 of the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive for reasons stated above with respect to the 35 U.S.C. § 102 rejection of claims 1-3, 5-7, 9, 10 and 13-17.

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Claims 1-3, 5-7, 9, 10, 13, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrási et al., U.S. Patent Numbers 5,639,751; 5,459,137; 5,521,174; 5,519,019; 5,604,223; and 5,536,832. For reasons of record and stated above.

7. The applicant's amendments are sufficient to overcome the 35 USC § 112, second paragraph rejection of the last office action, which are hereby **withdrawn**.

Claim Objections

8. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Allowable Subject Matter

9. Claim 4 is allowed. None of the prior art of record nor a search in the pertinent art area teaches the compounds of formula I as claimed herein.

Conclusion

10. Applicants' attention is directed to U.S. Patent Numbers 5,639,751; 5,521,174; 5,519,019; 5,604,223; and 5,536,832, claims subject matter that is similar and/or identical to that claimed herein. Two patents cannot issue on the same subject matter, unless applicants can demonstrate that the claims are patentably distinct from the claims of this US patent, the only way

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to overcome this patent is by way of Interference proceedings or removal of the conflicting subject matter. See MPEP 2306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays and Tuesdays from 9:00 AM to 3:00 PM and from 5:30 PM to 7:30 PM and on Wednesday thru Friday from 9:00 AM to 6:00 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Brenda Coleman
Primary Examiner AU 1624
April 23, 2002